



Paper No. 5

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OFFICE OF PETITIONS

In re Application of :
Ben-Haim, et al. :
Application No. 10/039,845 : ON PETITION
Filed: October 23, 2001 :
Attorney Docket No. 20066.84 :

This is a decision on the petition under 37 CFR 1.182, filed May 14, 2002, in response to the "Notice of Omitted Items in Nonprovisional Application (the 'Notice').".

The petition is dismissed.

Any request for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.182." This is not a final agency decision.

The application was filed on October 23, 2001. The Notice mailed March 14, 2002, indicated that the application had been granted a filing date, but stated that page 30 of the specification appeared to have been omitted from the application.

The Notice permits applicant to either: (1) promptly establish prior receipt in the Office of the items at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted items and accept the date of such submission as the application filing date. An applicant asserting that the missing items were in fact deposited in the Office with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted items in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted items with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such omitted items and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h) requesting the later filing date within two months of the date of the Notice (37 CFR 1.181(f)).

Petitioner asserts that the application filed October 23, 2001, included page 30 of the specification. Petitioner did not, however, provide sufficient evidence, i.e., an Office date-stamped postcard receipt to support this claim. In the alternative, petitioner argues that the transmittal sheet that accompanied the application identified the above-cited application as a continuation application of application No. 09/563,544 and specifically incorporated by reference the entire disclosure of the prior application.

An applicant may incorporate by reference the prior application by including in the application-as-filed, a

statement that such specifically enumerated prior application or application are "hereby incorporated by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior applications(s) will permit an applicant to amend the continuation application to include any subject matter in such prior application(s), without the need for a petition. See MPEP 201.06(c).

In view of the incorporation by reference of the prior application, page 30 is not new matter if it was a part of the disclosure of the prior application.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date October 23, 2001. Page 30 of the specification will not be entered at this time.

Thereafter, the application will be forwarded to the appropriate group art unit for consideration by the examiner of the petition filed May 14, 2002, as a supplemental preliminary amendment requesting entry of page 30 of the specification.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents and Trademarks
Box DAC
Washington, DC 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By Hand: Office of Petitions
Crystal Plaza 4, 3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries should be directed to Kenya A. McLaughlin, Petitions Attorney, at (703) 305-0010.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy
Accordingly